Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID P. MORICONI and DAN KIKINIS

Appeal No. 1999-1606
Application No. 08/968,384

ON BRIEF

Before THOMAS, KRASS, and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 6-13, all of the pending claims.

The invention is directed to a portable computer having a computer module and a detachable flat panel display module. The flat panel display module has a non-volatile memory which contains a single,

arbitrary code word unique to the type of display module. This permits newly developed displays to be used with previously manufactured computers by updating the computer BIOS and providing suitable drive routines for the newly developed displays.

. Representative independent claim 8 is reproduced as follows:

8. A flat panel display module comprising:

physical engagement apparatus for attaching the display module to a portable computer;

a multi-pin electrical connector for receiving commands and data from the portable computer to drive the display;

a non-volatile memory device connected to at least one pin of the multi-pin electrical connector and containing a single, arbitrary code word unique to the type of the display module.

The examiner relies on the following references:

Steiner	4,939,652	Jul. 03, 1990
Hogdahl et al. (Hogdahl)	5,264,992	Nov. 23, 1993
Sawdon	EP 0,456,923	Nov. 21, 1991

Improvements To Display Identification, IBM Technical Disclosure Bulletin, Vol. 33, No. 6B, November 1990, pp. 83-85.

Self-Identification Protocol Initialization, IBM Technical Disclosure Bulletin, Vol. 33, No. 10A, March 1991, pp. 406-407.

Claims 6-13 stand rejected under double patenting over claims 1 and 2 of U.S. Patent No. 5,262,759. Claims 6-13 stand further rejected under 35 U.S.C. 103. As evidence of obviousness, the examiner cites Hogdahl in view of either one of the IBM references and Sawdon with regard to claims 6-8 and 10-13, adding Steiner to this combination with regard to claim 9.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we will sustain, pro forma, the rejection of claims 6-13 based on double patenting since appellants have chosen not to argue the rejection [bottom paragraph on page 6 of the brief].

Turning now to the rejection under 35 U.S.C. 103, the examiner explains that Hogdahl discloses everything set forth in claims 6-8 and 10-13 but for the single arbitrary code word stored in a non-volatile memory in a display module. However, the examiner relies on either one of the IBM references to supply that deficiency. More specifically, the examiner points to page 85 of the 1990 IBM reference or, alternatively, pages 406-407 of the 1991 IBM reference for a display having a signal arbitrary identification code. The examiner then concludes that it would have been obvious to have modified Hogdahl with the teaching of either of the IBM references "so a display device could be identified by the main unit and a display system could be potentially compatible with an unlimited variety of display

devices" [answer-pages 3-4].

Further, the examiner relies on Sawdon for a teaching of identification codes stored in a non-volatile memory of a display module. The examiner then concludes that it would have been

obvious to further modify the modified Hogdahl system with the teaching of Sawdon "so the identification code would be changed if needed."

For their part, appellants contend that Hogdahl does not disclose a portable computer having a computer module and a detachable flat panel display hinged to close over the computer case to provide a compact package for transport and storage.

We disagree with appellants. Figure 4 of Hogdahl clearly shows that the flat panel display is detachable and there are many references, within column 1 alone, within Hogdahl that the computer may be a "portable" or "notebook-sized" computer. If the computer is of the "notebook-sized" variety, the skilled artisan would have recognized that the display would be "hinged to close over the computer case to provide a compact package for transport and storage." But, in any event, it is unclear as to what claim language appellants rely for this argument since we find no such language in the claims before us. The closest language appears to be in claim 11 which recites "hinged mounting structure" but appellants do not appear to separately argue the limitations of claim 11.

With regard to the IBM references, appellants contend that these references are concerned with a

PS/2 CRT monitor which would not be applicable to a flat panel display as used with a laptop or other portable computer "because the laptops do not connect and send information in the same manner that a desktop sends display info to a standalone CRT" [brief-page 8].

We are unpersuaded by this argument since appellants do not explain how the manner of connection and sending information differs between a portable computer, as claimed, and the computer taught by IBM. Thus, we are unconvinced that the teachings of the IBM references would not be applicable to flat panel displays. The important teaching of the IBM references is that they suggest that a display monitor and a display adaptor can determine whether the other supports a self-identifying protocol (IBM-1991) and that a display may comprise circuitry for sensing attachment to different levels of a display adapter and for transmitting a different identification (ID) code in each case (IBM-1990).

Thus, since Hogdahl teaches a detachable flat panel display and the IBM references teach the desirability of including circuitry in a display for sensing attachment to various adapters, or various levels of adapters, and transmitting a different ID code for each level of adapter, it would not be unreasonable to conclude that the skilled artisan would have been led to include such circuitry in the flat panel display of Hogdahl in order to transmit a different ID code for each different adapter to which it is connected when attaching to a different computer base unit.

Nevertheless, the instant claims each requires that the flat panel display module comprise a non-volatile memory which contains a "single, arbitrary code word" unique to the type of display module.

The IBM references do not disclose or suggest that there is a single, arbitrary code word that is unique to the type of display module. Rather, the IBM references suggest that the display panel transmits a different ID code for each adapter. Thus, the display panel of the IBM references do not contain a "single, arbitrary code word" unique to the type of display module. Further, the IBM references do not suggest that the display panel has a non-volatile memory which contains this "single, arbitrary code word" that is unique to the display module.

Accordingly, in order for the rejection to be proper, the noted deficiencies need to have been suggested by Sawdon since it is the final reference relied upon by the examiner.

The examiner points to Figures 1 and 2, column 3, lines 50-58, column 4, lines 1-19 and column 5, lines 30-34 of Sawdon as evidence of providing identification codes stored in the non-volatile memory of a display module and concludes therefrom that it would have been obvious to have included such a non-volatile memory containing such an identification code in Hogdahl, as modified by the IBM references.

Sawdon clearly does disclose a non-volatile memory in a display monitor, and appellants fairly admit as much at page 9 of the brief. However, appellants argue, Sawdon does not disclose the storage of a "single, arbitrary code word" which is then matched in the host with a driver and necessary data to drive the display. As appellants argue, at page 9 of the brief, an artisan "would not discern from Sawdon a need for a minimum memory (one code word)." The examiner offers no response to this

argument by appellants that the recitation of "a single, arbitrary code word" in the instant claims distinguishes over the applied references.

We will summarily reverse the rejection of claims 6-13 under 35 U.S.C. 103 because we simply do not understand what appellants intend by the claimed "single, arbitrary code word" even though appellants' main argument stresses this limitation as a distinguishing feature of the invention. One cannot apply art in a rejection under 35 U.S.C. 103 if claim interpretation is confusing under 35 U.S.C. 112. In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). Our reversal of the rejection based on 35 U.S.C. 103 should not be considered as a commentary on the substance, or merits, of the examiner's rejection. We simply cannot make a substantive decision regarding obviousness based on speculation when certain claim language is confusing.

We make the following new grounds of rejection in accordance with 37 CFR 1.196(b).

Claims 6-13 are rejected under 35 U.S.C. 112, second paragraph, as failing to particularly point out and distinctly claim the invention. The phrase, "single, arbitrary code word" is not clearly understood. It is not clear whether a "single" code word means one bit, or 8 bits, which is normally considered a "word," in computer jargon. Or, perhaps, any length of code is acceptable as long as it comprises only one, or a single, code. We are unsure and the specification fails to explain what is meant by a "single" code word. Similarly, the specification fails to explain what is meant by an "arbitrary" code word. Wouldn't a code word be specific to the type of display panel or the type of interface to which it is

connected? If so, how can this be said to be "arbitrary"?

Claims 6-13 are further rejected under 35 U.S.C. 112, first paragraph, as relying on an inadequate written description. While the claims all recite a "single, arbitrary code word," we find no support for this recitation in the original disclosure. Page 10 of the specification, at line 13, recites storing "a code" and the bottom of page 10 recites the programming of an EEPROM "with a unique identity code." However, we find nothing disclosed relative to "single, arbitrary code word." In fact, the disclosure of a "unique" identity code stored in an EEPROM would appear to be completely different from a code that is "arbitrary." Further, the sentence bridging pages 10 and 11 recites that each "type of module offered for the computer has a specific identity code." Again, "specific" codes would appear to be completely different from codes which are "arbitrary," as claimed. It appears that appellants amended the claims to include a "single, arbitrary code word" in order to overcome the applied prior art. However, there is no support for such a claim
limitation in the original disclosure and appellants have never adequately explained what is meant by such a limitation nor how it distinguishes over the code words of Sawdon.

CONCLUSION

We have affirmed the examiner's decision of claims 6-13 with regard to double patenting and we have reversed the examiner's decision rejecting claims 6-13 under 35 U.S.C. 103, but we have entered

new grounds of rejection, in accordance with 37 CFR 1.196(b), under 35 U.S.C. 112, first and second paragraphs.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellants may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with

respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Affirmed - 37 CFR § 1.196(b)

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	BOARD OF PATENT
	)	APPEALS AND
ERROL A. KRASS	)	INTERFERENCES
Administrative Patent Judge	)	
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